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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,499	11/05/2003	Shinji Tai	245062US	6280

22850 7590 11/02/2006

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EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT PAPER NUMBER

1713

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/700,499	<b>Applicant(s)</b> TAI ET AL.	
	<b>Examiner</b> Dr. Kelechi C. Egwim	<b>Art Unit</b> 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-22 is/are pending in the application.
- 4a) Of the above claim(s) 18-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/680,966.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Due to amendments and persuasive arguments by applicant, the previous rejections of record based on Tai et al. have been overcome and are hereby withdrawn.

#### ***Election/Restrictions***

2. Claims 18-22 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

#### ***Claim Objections***

3. Claim 1 is objected to because of the following minor informality: The "≤" between "ETB2" and "48" in claim 14 is missing.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 14-17 is rejected under 35 U.S.C. 102(b) as being anticipated by Negi et al. (JP'656), for reason cited in the previous action.

***Claim Rejections - 35 USC § 103***

6. Claims 14-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Negi et al. (JP'736 or JP'757), and under 35 U.S.C. 102(e) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Hata et al., for reason cited in the previous action.

***Response to Arguments***

7. Applicant's arguments filed 08/14/2006 have been fully considered but they are not persuasive.

8. Regarding JP '656, while applicant argues that "[t]here is no statement in the reference regarding the control of the range of the degrees of saponification of the two polymers", JP '656 teach that both of the copolymers have a degree of saponification of at least 96, which translates to a range of  $0 \leq |SCB1 - SDB2| \leq 4$ , which overlaps with the claimed range of  $1 \leq SCB1 - SDB2 \leq 8$ .

Further, applicant argues that "[t]he reference also does not show the need to control the ethylene contents and the differences in the contents required by the present claims", JP '656 teach  $5 \text{ (from 45\%-40\%)} \leq ETB2 - ETB1 \leq 35 \text{ (from 60\%-25\%)}$ , which encompassed the claimed range of  $8 \leq ETB2 - ETB1 \leq 23$ .

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Thus, the requirements for rejection based on JP '656 are met.

9. Regarding the argument that prior art may or may not appreciate the importance of the difference between the two copolymers, applicant is reminded that the anticipatory prior art is not limited to the examples or even preferred embodiment. As long as the invention is taught, it is anticipated.

10. Regarding Negi et al. JP '736 and the argument that the difference in the degrees of saponification in its examples are outside the claimed range of between 1-8, it is well settled that anticipatory teachings are not limited to any particular embodiment/example. In re Boe, 148 USPQ 507 (CCPA 1966). Disclosed examples and preferred embodiments (even if the embodiments tested by appellant were preferred) do not constitute a teaching away from a broader disclosure. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

Negi et al. teach that the degrees of saponification of copolymer (A) is greater than that of copolymer (B), or stated another way,  $DS(A) - DS(B)$  is greater than zero, which encompassed the claimed range of 1-8.

11. Regarding Negi et al. '757, in the abstract, Negi et al. teach

$4 \leq ETB2 - ETB1$ , and

$3 \leq SDB1 - SDB2$

Thus, the requirements for rejection are met

12. Regarding Hata et al., a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

While applicant argues "there is nothing in the reference teaching or suggesting the particular control on the ranges of degree of saponification and ethylene content when determining differences in those contents between the first and second copolymer", the table reproduced in applicant's own arguments demonstrates a range of 6 to 19 for ET(B)-ET(A) and a range of 0 to 3.7 for SD(A)-SD(B) in Hata et al. Each of which, at least, overlap with applicant's claimed ranges of 8 to 23 and 1 to 8, respectively.

13. Regarding the argument that the blends of Hata et al. contain ethylene-(meth)acrylic acid copolymer, the present claims do not exclude these polymers from the claimed blends. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCE

  
KELECHIC. EGWIM PH.D.  
PRIMARY EXAMINER